

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

TN

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/142,452 01/19/99 WACK

0 19866.PCT/FA

EXAMINER

IM52/0828

ROBERT W. BECKER & ASSOCIATES
11896 N. HIGHWAY 14,
SUITE B
TIJERAS NM 87059

MARKOFF, A

ART UNIT

PAPER NUMBER

1746

18

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Applicant No.

09/142,452

Applicant(s)

WACK ET AL.

Examiner

Alexander Markoff

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required. It is noted that the same requirement was made in the previous Office action. The Applicants failed to comply with this requirement. The requirement is made again.

Election/Restrictions

2. It is noted that the instant claims are directed to two distinct inventions (method and composition), which can be properly restricted. The restriction requirement is not made this time because the same prior art can be applied to reject both of the inventions. The Applicants, however, advised that if the claims would be amended to require separate consideration and/or search the restriction requirement could be made.

Response to Amendment

3. The amendments filed 11/22/00 and 6/4/01 are objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is as follows: the range for the amount of water in claims 47-65.

It is noted that the Applicants again argue that the support for the range can be found in the specification in the paragraph starting with "In an especially preferred embodiment...". It is also noted that it is not clear for the Applicants whether or not the numbers of the pages of the Office's file and the Applicant's file correspond to each other. Thereby a copy of the originally filed disclosure is attached to the instant Office action.

The copy of the disclosure clearly shows that the claimed range is not supported.

The Applicants also amended claim 61 to recite compounds and geniuses, which are not supported by the original disclosure. See the attached copy of the original disclosure as an evidence.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 47-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims recite the range for amount of water, which is not supported by the original disclosure.

Claim 61 as amended recites the compounds and the geniuses for the groups, which are not supported by the original disclosure.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 47-67 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because it is not clear what is referenced as a temperature "a cleaning process temperature".

All claims reciting "azeotrope" are also indefinite because it is not clear what is meant by the Applicants as "azeotrope". Conventionally this term means: A liquid mixture of two or more substances that retains the same composition in the vapor state as in the liquid state when distilled or partially evaporated under a certain pressure.¹ The Applicants however argue that "a liquid composition having an azeotropic behavior need not have its components in the same percentages as its vapor". This argument is also raises a question whether or not the Applicants provided an adequate written disclosure of their invention. The clarification is requested.

It is noted, that while applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

Claim 49 is also indefinite because it is not clear what cleaning should be "undertaking" under "the effect of ultrasonic". This claim is also indefinite because the term "the effect of ultrasonic" lacks proper antecedent basis.

Claim 50 is indefinite and incomplete because it lacks the step of forming the vapor, which should be condensed.

Claim 61 is also indefinite because it is not clear how can "-X-" be "-NR¹", how can C2 alkylene group comprise nonadjacent "-CH₂-" groups, etc.

It is believed that most of the deficiencies of the claims were pointed out. However, the Applicants assistance is again requested to place the claims in the format proper for the US patent practice.

The Applicants are also encouraged to check the copy of the original disclosure attached to the instant Office action and to place the claims into the correspondence with that disclosure.

Claim Objections

8. Claim 51 is again objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim fails to further limit the previous claim because claim 50 recites an azeotropic composition, i.e. the composition in which the liquid and the vapor has the same composition.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 47, 48, 50, 51, 54, 55, 57, 58, 60, 61, 66 and 67 are rejected under 35 U.S.C. 102(b) as being anticipated by EPA 475,596.

EPA 475,596 teaches (entire document, especially columns 4 and 5) a method for cleaning articles by contacting them with a liquid mixture of water with an organic compound or with a vapor of the mixture of water and the organic compound to remove contaminants from the article. The vapor is allowed to condense on the article. The mixture forms an azeotrope during the "liquid phase-to-vapor phase transition.

11. Claims 47-51 and 53-67 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 96/28535.

WO 96/28535 teaches a method for cleaning articles comprising the same steps as claimed utilizing the composition as claimed. The reference teaches the specifically claimed chemicals as preferred ones. It is inherent that the same composition has the same properties.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claim 52 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 96/28535.

WO 96/28535 teaches the same method as claimed except for the use of a filter.

However, the reference teaches purification and separation of the composition. Filtration is one of the most common methods for purification and separation. Accordingly, it would have been obvious to an ordinary artisan at the time the invention was made to incorporate filter for it's primary purpose in the method of WO 96/28535 with reasonable expectation of adequate results in order to use a conventional method and device for their conventional purpose.

Response to Arguments

16. Applicant's arguments filed 6/4/01 have been fully considered but they are not persuasive.

It is believed that the Applicants arguments regarding the rejections based made under 35 USC 112 were addressed above.

As to the art rejections:

The Applicants argue that EP 475596 does not teach miscibility gap. The Applicants cite several lines of the reference taken alone. It is not persuasive because the entire teaching of the reference should be considered. The Applicant's attention is again directed that the reference teaches the claimed invention in the entire disclosure, especially in column 4 and 5, but also columns 6 and 7. It is again noted that the reference

clearly recites that the cleaning mixture forms azeotrope and is subjected to the phase separation after condensation.

With respect to the rejection based on the teaching of WO 96/28535, it is noted that the Applicant's arguments are more specific than the claims. It is again noted that the reference teaches the use of a cleaning composition having the claimed components in the claimed ranges and that the steps of the disclosed cleaning method are the same as the steps of the claimed method.

It is further noted that the Applicants statement (presented in lines 6-17 on page 10 of the Remarks) alleging that WO 96/28535 does not teach the claimed composition and method because it (according to the Applicants) does not teach contacting the article with a specific composition, contradicts to the fact that the reference teaches the use of the same composition – same components, same proportions, etc.

The examiners position is that the claimed process and the process disclosed by WO 96/28535 are the same. WO 96/28535 even recites all the specifically claimed chemicals as preferred. See, for example, recitation of dipropylene glycol mono n-propyl ether on page 11.

If the process of the invention is different from what is disclosed by the reference it should be clearly recited by the claims.

C nclusion

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 703-308-7545. The examiner can normally be reached on Monday - Friday 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on 703-308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7719 for regular communications and 703-305-7718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
703-308-0651.

A handwritten signature in black ink, appearing to read 'Alex Markoff', written in a cursive style.

Alexander Markoff
Primary Examiner
Art Unit 1746

am
August 27, 2001

ALEXANDER MARKOFF
PRIMARY EXAMINER